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Robert C. Meier

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EXAMINER

DINH, KHANH Q

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 10/790,631	Applicant(s) MEIER, ROBERT C.	
	Examiner Khanh Dinh	Art Unit 2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-39 are presented for examination.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-21, 23-28, 34, 35 and 39 of the instant application are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over some claims of U.S. Patent No. 6,701,361.

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Regarding claims 1-11, claims 1, 2, 3, 7-14 of U.S. Patent No. 6,701,361 contains every element of claims 1-11 of the instant application and as such anticipate claims 1-11 of the instant application.

Regarding claims 12-19, claims 1, 1, 3, 12, 11, 12, 13 and 14 of U.S. Patent No. 6,701,361 contains every element of claims 12-19 of the instant application and as such anticipate claims 12-19 of the instant application.

Regarding claims 20, 21, 23-27, claims 1, 1, 11, 11, 12-14 of U.S. Patent No. 6,701,361 contains every element of claims 20, 21, 23-27 of the instant application and as such anticipate claims 20, 21, 23-27 of the instant application.

Regarding claims 28, 34, 35 and 39, claims 1, 11, 1, and 11 of U.S. Patent No. 6,701,361 contains every element of claims 28, 34, 35 and 39 of the instant application and as such anticipate claims 28, 34, 35, 39 of the instant application.

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. In re Longi, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); In re Berg, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " ELI LILLY AND COMPANY v BARR LABORATORIES, INC., United States Court of Appeals for the

Federal Circuit, ON PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Art Rejection

Claim Objections

4. Claim 12 is objected to because of the following informalities: "concatentated" (in line 4) should be changed to "concatenated".

Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-39 are rejected under 35 U.S.C. 102(e) as being anticipated by Cheung et al. US pat. No.5,953,507.

As to claim 1, Cheung discloses a communication network providing wireless communication within a premises, the wireless network comprising:

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a wired network (10 fig.2) operating according to a wired protocol, the wired network having a first network segment and a second network segment (connecting a mobile device to a stationary desktop, see abstract, fig.2, col.4 line 66 to col.5 line 25);

a wireless terminal (MPC 14 fig.2) having a wired network protocol address and a first access point coupled to the first network segment (using wireless communication, see col.5 lines 26-49);

a second access point coupled to the first network segment and a data link tunnel that communicatively couples the second access point to the first access point when the wireless terminal is in wireless communication with the second access point (see col.5 line 50 to col.6 line 19).

As to claims 2 and 3, Cheung discloses the first access point is connected to the first network segment and wherein a protocol tunnel communicatively couples the first access point to the second network segment (see col.6 lines 11-60).

As to claims 4 and 5, Cheung discloses a third access point connected to the second network segment and the wireless terminal has a wired network protocol address respective to the third access point (see col.6 line 47 to col.7 line 56).

As to claims 6 and 7, Cheung discloses the first access point and the third access point are communicatively coupled with a protocol tunnel and routed communication through the data link tunnel uses a different protocol scheme than when routed through the

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protocol tunnel (see col.6 lines 21-60 and col.7 lines 3-57).

As to claims 8 and 9, Cheung discloses that the wired network operates under the Internet protocol and wherein the data link tunnel operates across the wired network (see col.6 line 47 to col.7 line 56).

As to claims 10 and 11, Cheung discloses that the data link tunnel operates across a radio link and routed communication from the first tunnel is not bridged onto the second network segment (see col.1 lines 18-30 and col.6 line 47 to col.7 line 56).

As to claim 12, Cheung discloses a communication network comprising:

a wired network (10 fig.2) having a first network subnet and a second network subnet; a first tunnel coupling the first network subnet with the second network subnet (connecting a mobile device to a stationary desktop, see abstract, fig.2, col.4 line 66 to col.5 line 25); a roaming terminal communicatively coupled with the first network subnet (using wireless communication, see col.5 lines 26-49); and a second tunnel concatenated with the first tunnel to provide a logical extension of the first subnet for the roaming terminal (see col.5 line 50 to col.6 line 19).

As to claim 13, Cheung discloses the communication network further sends a data message destined to the roaming terminal as a first message under a first network protocol, the first message encapsulating a second message under a second network

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protocol, the second message encapsulating a message under the wired network protocol (see col.6 lines 11-60).

As to claims 14-17, Cheung discloses that the second network protocol is a wireless network protocol, the second network protocol is a wired network protocol, the wired network operates under an Internet protocol and the second tunnel operates across the wired network (see fig.3, col.6 lines 21-60 and col.7 lines 3-57).

As to claims 18 and 19, Cheung discloses the second tunnel operates across a radio link and a routed communication from the first tunnel is not bridged onto the second network subnet (see col.6 lines 21-60 and col.7 lines 3-57).

As to claim 20, Cheung discloses a communication network comprising:
a wired network (10 fig.2) having a first network subnet and a second network subnet and a first tunnel coupling the first network subnet with the second network subnet (connecting a mobile device to a stationary desktop, see abstract, fig.2, col.4 line 66 to col.5 line 25);
a roaming terminal communicatively coupled with the first network subnet (using wireless communication, see col.5 lines 26-49); and
a second tunnel concatenated with the first tunnel to provide a logical extension of the first subnet for the roaming terminal without requiring the dynamic assignment of

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pseudo addresses (see col.5 line 50 to col.6 line 19).

Claims 21-27 are rejected for the same reasons set forth in claims 13-19 respectively.

As to claim 28, Cheung discloses a communication network providing wireless communication within a premises, the wireless network comprising:

a wired network (10 fig.2) operating according to a wired protocol, the wired network having at least a first network segment and a second network segment (connecting a mobile device to a stationary desktop, see abstract, fig.2, col.4 line 66 to col.5 line 25);

a wireless terminal (MPC 14 fig.2) having a wired network protocol address, a first fixed access point connected to the second network segment and a second fixed access point connected to the second network segment (using wireless communication, see col.5 lines 26-49); and

a data link tunnel that communicatively couples the first and the second fixed access points via wireless communications only such that bridging communication data onto the second network segment is avoided when communications between one of the fixed access points and the wireless terminal require communication with the other fixed access point (see col.5 line 50 to col.6 line 19 and col.7 lines 3-48).

As to claims 29-30, Cheung discloses the data link tunnel comprises a radio link between the first and the second fixed access points and the wireless terminal is a roaming terminal (see col.6 lines 21-60 and col.7 lines 3-57).

As to claims 31 and 32, Cheung discloses the first fixed access point encapsulates a message in a packet for transmission via the data link tunnel to the second fixed access point such that the message is supplied to the wireless terminal without the use of pseudo addresses which are dynamically assigned to roaming terminals and a router that couples the first and the second network segments (see col.6 line 47 to col.7 line 56).

As to claims 33 and 34, Cheung discloses that the first network segment and the second network segment have different sub-network addresses and the wired network operates according to an Internet protocol (see fig.3, col.6 lines 21-60 and col.7 lines 3-57).

As to claim 35, Cheung discloses a communication network comprising:
a wired network (10 fig.1) having a first network access point and a second network access point; a data link tunnel communicatively coupling the first network access point with the second network access point via wireless communications only (connecting a mobile device to a stationary desktop, see abstract, fig.2, col.4 line 66 to col.5 line 25);
and
a roaming terminal communicatively coupled to the first network access point wherein communications from the roaming terminal pass within the data link tunnel to the

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second network access point (using wireless communication, see col.5 lines 26-49 and col.7 lines 3-48); and

As to claims 36 and 37, Cheung discloses the data link tunnel comprises a radio link between the first and the second network access points and the roaming terminal is a wireless terminal (see col.1 lines 18-30 and col.6 line 47 to col.7 line 56).

As to claims 38 and 39, Cheung discloses the first network access point encapsulates a message in a packet for transmission via the data link tunnel to the second network access point such that the message is supplied to the wireless terminal without the use of pseudo addresses which are dynamically assigned to roaming terminals and the wired network operates according to an internet protocol (see fig.3, col.6 lines 21-60 and col.7 lines 3-57).

Other prior art cited

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Marberg et al, US pat. No.5,943,692.
- b. Mills et al, US pat. No.5,881,235.
- c. Holmes et al, US pat. No.5,946,615.
- d. Lazaridis et al., US pat. No.5,802,312.
- e. Coleman et al., US pat. No.6,006,090.

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Conclusion

8. Claims 1-39 are rejected.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh Dinh whose telephone number is (571) 272-3936. The examiner can normally be reached on Monday through Friday from 8:00 A.m. to 5:00 P.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung, can be reached on (571) 272-3939. The fax phone number for this group is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any response to this action should be mailed to:

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